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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,001	01/10/2000	Akitsugu Ohyoshi	FUJY 14.298	5037

26304 7590 02/12/2003

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EXAMINER

PHILIP, NOBEL A

ART UNIT

PAPER NUMBER

2697

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/481,001

Applicant(s)

OHYOSHI ET AL.

Examiner

Nobel Philip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claims 2-8 objected to because of the following informalities:
  - Referring to claim 2, it is suggested that the statement "according to the claim 1" be changed to "according to claim 1" and the statement "through the each channel" be changed to "through each channel".
  - Referring to claim 3, it is suggested that the statement "according to the claim 1" be changed to "according to claim 1" and the statement "for the each channel" be changed to "for each channel".
  - Referring to claims 4-6, it is suggested that the statement "according the claim 1" be changed to "according to claim 1" and the statement "through the each channel" be changed to "through each channel". Also, in claim 6, the term "message" is misspelled.
  - Referring to claim 7, it is suggested that the statement "according the claim 1" be changed to "according to claim 1" and the statement "for the each channel" be changed to "for each channel".
  - Referring to claim 8, it is suggested that the statement "according to the claim 1" be changed to "according to claim 1".

Appropriate correction is required.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,094,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a frame relay switch comprising a data quantity measurement, restrictive level operation, restrictive process storage, and traffic control means.

3. Claims 1, 9, 10, and 12 of the instant application merely broaden the scope of claim 1 of the Patent by eliminating the elements and their functions of the claims. It has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5, 8, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamo et al. (U.S. Patent No. 5,610,918).

- Referring to claims 1 and 9, Kamo discloses a network system and traffic control method in a network system comprising an ATM network (figure 1 – 103), plural frame relay networks connected to the ATM network (figure 1 – 110 & 120), and plural terminals connected to the frame relay networks (figure 1 – 101 & 102). Kamo further discloses that the traffic control method comprises the steps of measuring a data quantity transmitted through each channel (the virtual band calculation means determine the usage of the channel, col. 22 lines 41-46), operating a traffic restrictive level corresponding to the data quantity measured (determining whether a call should be accepted depending on virtual band calculation, col. 22 lines 33-46), and performing a traffic restrictive process corresponding to a level of the traffic restrictive level which is operated about each channel (accepting or dropping a call, col. 22 lines 33-40).
- Referring to claim 2, Kamo further discloses a traffic control method wherein the data quantity is measured as to data transmitted from each of the plural frame relay networks to the ATM network through each channel (the virtual band calculation means, col. 22 lines 41-46).

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- Referring to claim 5, Kamo further discloses that the restrictive process include discarding data (dropping call, col. 22 lines 33-40).
- Referring to claim 8, Kamo further discloses at least one of the plural terminals is connected to the ATM network through no frame relay network (see fig. 18 – 201, col. 40 lines 28-42).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamo et al. (U.S. Patent No. 5,610,918) in view of Yamato et al. (U.S. Patent No. 5,694,390).

- Referring to claim 3, Kamo discloses a network system and traffic control method in a network system comprising an ATM network, plural frame relay networks connected to the ATM network, and plural terminals connected to the frame relay networks (see claim 1 above). Kamo further discloses that the traffic control method comprises the steps of measuring a data quantity transmitted through each channel, operating a traffic restrictive level corresponding to the data quantity measured, and

performing a traffic restrictive process corresponding to a level of the traffic restrictive level which is operated about each channel (see claim 1 above). Kamo does not expressly disclose performing a traffic restrictive process corresponding to the restrictive class. Yamato discloses performing a traffic restrictive process corresponding to the restrictive class (col. 1 lines 55-58, col. 12 lines 20-39). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to perform a traffic restrictive process corresponding to the restrictive class. One of ordinary skill in the art would have been motivated to do this in order to give higher priority to packets with greater importance during congestion periods.

- Referring to claims 4, 6, and 7, Kamo discloses a network system and traffic control method in a network system comprising an ATM network, plural frame relay networks connected to the ATM network, and plural terminals connected to the frame relay networks (see claim 1 rejection above). Kamo further discloses that the traffic control method comprises the steps of measuring a data quantity transmitted through each channel, operating a traffic restrictive level corresponding to the data quantity measured, and performing a traffic restrictive process corresponding to a level of the traffic restrictive level which is operated about each channel (see claim 1 rejection above). Kamo does not expressly disclose the writing of information indicating that congestion occurred or transmitting a message to a terminal indicating congestion. Yamato discloses writing information indicating that congestion occurred (setting EFCI bit, col. 7 lines 10-15) and Yamato further discloses that it is well known that a process of congestion control can include notifying the terminal of a congestion state (col. 1 lines 28-38). At

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the time the invention was made, it would have been obvious to a person of ordinary skill in the art to write information that congestion occurred and notify the terminal of a congestion state. One of ordinary skill in the art would have been motivated to do this in order to recognize and recover from a network congestion state.

6. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamo et al. (U.S. Patent No. 5,610,918) in view of Sone (U.S. Patent No. 5,675,642).

- Referring to claims 10 and 12, Kamo further discloses a frame relay switch in a network system comprising an ATM network, plural frame relay networks respectively connected to the ATM network through channels, plural terminals connected to the frame relay networks, a data quantity measurement portion, and a restrictive level operation portion operating a traffic restrictive level corresponding to the data quantity (see claim 1 rejection above). Kamo does not expressly disclose a restrictive process storage portion and a traffic control portion for reading out information of the restrictive process storage portion. Sone discloses a network system having a restrictive process storage portion and a traffic control portion for reading out information of the restrictive process storage portion (the parameter converting unit and control processing unit, col. 13 lines 41-49). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have a restrictive process storage portion and a traffic control portion for reading out information of the restrictive process storage portion. One of ordinary skill in the art would have been motivated to do this in order to perform flow control based on information from the network.

- Referring to claim 11, Kamo further discloses at least one of the plural terminals is connected to the ATM network through no frame relay network (see fig. 18 – 201, col. 40 lines 28-42).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Kajiwara et al. (U.S. Patent No. 5,315,588) discloses a method of controlling a frame-relay module and high speed switching system.

b) Ma et al. (U.S. Patent No. 5,953,338) discloses dynamic control processes and systems for ATM networks.

c) Koga et al. (U.S. Patent No. 5,963,541) discloses a traffic control apparatus.

d) Graham et al. (U.S. Patent No. 6,097,722) discloses bandwidth management processes and systems for ATM networks using variable virtual paths.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nobel Philip whose telephone number is 703-305-8395. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 703-305-4798. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, DC 20231

**or faxed to:**

(703) 305-3988, (for formal communications intended for entry)

**Or:**

(703) 305-3988, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Nobel Philip  
February 4, 2003

**RICKY NGO  
PRIMARY EXAMINER**

